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10/655,571	09/04/2003	John A. Sazy	101896-706 (DEP-128CON)	6429
21125 7590 12/23/2010 NUTTER MCCLENNEN & FISH LLP SEAPORT WEST 155 SEAPORT BOULEVARD BOSTON, MA 02210-2604			EXAMINER PELLEGRINO, BRIAN E	
			ART UNIT 3738	PAPER NUMBER
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UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte* JOHN A. SAZY

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Appeal 2009-007953  
Application 10/655,571  
Technology Center 3700

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Before WILLIAM F. PATE, III, STEFAN STAICOVICI, and  
FRED A. SILVERBERG, *Administrative Patent Judges*.

STAICOVICI, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING<sup>1</sup>

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<sup>1</sup> The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the “MAIL DATE” (paper delivery mode) or the “NOTIFICATION DATE” (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

## STATEMENT OF THE CASE

John A. Sazy (Appellant) filed a “Response to Decision on Appeal to Reopen Prosecution and Amendment for Reconsideration by [the] Examiner” on August 9, 2010 (hereinafter “Response”) from the decision of this Board mailed June 11, 2010 (hereinafter “Decision”).

The Decision reversed the rejection of claims 1, 3, 5, 6, and 10-31 under 35 U.S.C. §§ 102(b) and 103(a). The Decision further entered a new ground of rejection of claims 1, 3, 5, 6, and 10-31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In the Response, Appellant adds new claims 32-44 and provides new evidence of the meaning of the term “banana-shaped” in the form of a journal paper entitled “Comparison of cage designs for transforaminal lumbar interbody fusion: A biomechanical study,” W. Cho *et al.*, 23 Clinical Biomechanics 979 (2008) (Hereinafter “Cho”). Response 6-8 and 12.

Appellant contends that the Board overlooked or misapprehended the issue that the term “banana-shaped” is indefinite because the Cho paper shows that a person of ordinary skill in the art would know what a “banana-shaped” prosthesis is and as such, “would find no ambiguity in the term banana-shaped.” Response 14.

## ANALYSIS

In view of our new ground of rejection of claims 1, 3, 5, 6, and 10-31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention, Appellant chose to reopen prosecution before the Examiner by filing both an amendment and new evidence. Response 1, 6-8

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and 12. *See* 37 CFR 41.50(b)(1). However, in the Advisory Action mailed August 24, 2010, the Examiner found that the amendment submitted by Appellant was inappropriate because the amendment added new claims without either amending the rejected claims or substituting new claims for the rejected claims. *See* MPEP § 1214.01(I). Accordingly, the Examiner correctly did not enter the new claims and returned the application file to the Board for consideration of the amendment as a request for rehearing under 37 CFR 41.50(b)(2). *See Id.*

Appellant argues that the term “banana-shaped” is not indefinite because Figure 1a of Cho shows a banana-shaped cage. Response 12. Accordingly, Appellant asserts that because Figure 1a of Cho shows a banana-shaped cage “[t]here can be no doubt that persons of ordinary skill in this art know what a banana shaped cage is.” Response 13. However, we note that the disclosure of Cho was not before us when the decision of this Board was made (the Decision was mailed June 11, 2010). Cho’s paper was filed subsequent to the Decision, specifically, it was filed with the Response on August 9, 2010. It is a well-nigh insurmountable burden to convince this Board that we have overlooked material that was not submitted. Prescience is not a required characteristic of the Board. *Cf. Keebler Co. v. Murray Baking Prods.*, 866 F.2d 1386, 1388 (Fed. Cir. 1989). The Board need not divine all possible afterthoughts of counsel that might be asserted for the first time on appeal. *Id.* In conclusion, we could not have misapprehended or overlooked the indefiniteness of the term “banana-shaped” in view of Cho’s paper because Cho’s paper was not before us when we reached our decision.

### CONCLUSION

In light of the above, Appellant's Response fails to persuade us that we erred in entering a new ground of rejection of claims 1, 3, 5, 6, and 10-31 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Therefore, we have granted Appellant's request to the extent that we have considered our Decision in light of the points raised therein, but have denied the request with respect to any modification to the Decision.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv).

DENIED

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